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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,133	03/24/2004	Jean-Luc Perillon	1759.157	4558
23405	7590	09/21/2006	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC			RUDDOCK, ULA CORINNA	
5 COLUMBIA CIRCLE			ART UNIT	
ALBANY, NY 12203			PAPER NUMBER	

1771

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,133

Applicant(s)

PERILLON ET AL.

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/20/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 20, 2006, has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase "said varnish layer being a non-ink layer" is new matter, because this negative limitation is not literally supported by the specification. *Ex parte Grasselli*, 231 USPQ 393. In the specification, there is no mention of having a varnish layer with no ink. Applicant further claims "said adhesive layer remaining repositionable when cured." There is no support for this limitation in

the specification. These limitations are considered new matter and amendments to the claims are required to delete these new matter limitations.

Claim Rejections - 35 USC § 103

5. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray et al. (US 5,707,904) in view of Crouch et al. (US 5,895,705) and Paquette et al. (US 5,229,207). Gray et al. disclose a fabric for use as an awning comprising a woven scrim and a translucent coating on at least one side of the scrim (col 1, ln 53-54). The translucent coating is preferably plastisol and the scrim is formed of woven polyester yarns (col 1, ln 60-65). As seen in Figure 2, the scrim (reference point 30) is coated with an upper plastisol layer (reference point 20) and a lower plastisol layer (reference point 14). The plastisol layer is preferably a vinyl plastisol including a PVC resin and plasticizers (col 3, ln 1-4). A release paper (reference point 12) is also included in the fabric laminate. With regard to Applicant's "capable of" limitations, it has been held that a recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Gray et al. disclose the claimed invention except for the teaching that the laminate comprises a varnish layer and a repositionable pressure sensitive adhesive layer.

Crouch et al. (US 5,895,705) disclose an awning fabric comprising a varnish, i.e. acrylic resin, that is used in the ink, which further contains pigments (col 3, ln 24-33). The varnish is on the surface of a PVC plastisol coating layer that coats the fabric (col 3, ln 39-40).

Paquette et al. (US 5,229,207) disclose a film composite comprising a substrate useful in awnings (col 2, ln 7-9) and further comprising a layer of adhesive which is pressure sensitive (col 1, ln 68) and affords good repositionability (abstract).

It would have been obvious to one having ordinary skill in the art to have incorporated Crouch's varnish layer in the laminate of Gray et al. and Paquette, motivated by the desire to create a laminate that has ease of printing and has increased stiffness.

It also would have been obvious to have incorporated Paquette's repositionable pressure sensitive adhesive in the laminate of Gray et al. and Crouch, motivated by the desire to create laminate that has ease of handling and maneuverability.

Regarding claim 10, although Gray et al., Crouch et al., and Paquette et al. do not explicitly teach the claimed adhesive force, it is reasonable to presume that this property is inherent to the invention of Gray et al., Crouch et al., and Paquette et al. Support for said presumption is found in the use of like materials (i.e. scrim coated on both sides with a PVC plastisol, a varnish one side, a repositionable pressure sensitive adhesive on the other side, and release paper). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the presently claimed property of a pressure sensitive adhesive layer possessing an adhesive force between 1 and 100 Newton, for a strip with a width of 5 cm, would obviously have been present once the Gray et al., Crouch et al., and Paquette et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

Response to Arguments

6. Applicant's arguments filed July 20, 2006, have been fully considered but they are not persuasive for the reasons set forth. Applicant argues that Crouch's varnish layer is not printable nor is there an ink layer deposited thereon. This argument is not persuasive because Crouch specifically discloses printing at column 2, lines 20-22. Crouch further discloses that the ink layer comprises pigments and varnish at column 3, lines 24-26. Therefore, the rejections are maintained.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UCR *Uen*

Ula Ruddock
G. Ruddock
Primary Examiner
Tech Center 1700